

REMARKS

Claims 1-20 and 22-47 are pending, with claims 1, 25, 39, and 47 being independent. Claims 1, 25-27, 29, 30, 32, 34-43, 45, and 46 have been amended, claim 21 has been canceled and incorporated into amended claim 1, and claim 47 has been added. Support for the amendments and the new claim can be found in the originally-filed specification at least at page 1, line 16 to page 4, line 16. No new matter has been added.

Objections to Drawings

Applicant requests withdrawal of the objections for the following reasons, which are believed to address all of the Examiner's concerns. First, applicant has added the reference "510" to Figs. 2B, 5, and 6A to comply with 37 CFR §1.84(p)(5). Second, the reference numbers "902" and "904" are mentioned in the specification at least at page 9, line 4, and therefore the appearance of these reference numbers in Figs. 9A and 9D is proper under 37 CFR §1.84(p)(5). Third, applicant has added the reference "534" to the open lead lines in Fig. 2B to comply with 37 CFR §1.84(q).

Objections to Specification

Applicant has amended the specification to correct the errors listed by the Examiner. Accordingly, applicant requests withdrawal of this objection.

Rejection of Claims 1-5, 7, 8, 14-17, 19, 25-31, 35-37, 39-45

Claims 1-5, 7, 8, 14-17, 19, 25-31, 35-37, and 39-45 have been rejected as being anticipated by U.S. Patent No. 3,199,248 (Suzuki). Applicant requests withdrawal of this rejection for the reasons provided below.

Independent claim 1 recites a toy including a body, a motor within the body, an appendage, a tail device, and a neck device. The appendage is coupled to the body of the toy and actuated by the motor to move relative to the body along a first path, with the movement including movement of an end of the appendage along a non-circular path. The tail device is

coupled to the body of the toy and actuated by the motor to move relative to the body along a second path. The neck device is coupled to the body of the toy and actuated by the motor to move relative to the body along a third path. Applicant requests withdrawal of this rejection because Suzuki fails to describe or suggest movement relative to a body of an end of an appendage along a non-circular path, as recited in claim 1.

Suzuki relates to an animated toy parrot. See Suzuki at abstract and Fig. 1. The parrot includes a hollow body 1, a head 7 attached to the body 1, a beak part 9 on the head 7, a tail 11 attached to the body 1, and wings 23 attached to the body 1. See Suzuki at col. 2, lines 36-42 and Figs. 1-3. The body 1 houses a motor 2 that rotates cranks 3 and 4 within the body 1. See Suzuki at 55-60 and Figs. 2 and 3. Suzuki's motor 2 drives the crank 4, which is coupled to the wings 23 by way of a disk 19 to move the wings 23 away from the body about a wing axis, and which is coupled to the head 7 by way of a stem 15 to move the head 7 side to side about a head axis that is perpendicular to the wing axis. See Suzuki at col. 2, line 67 to col. 3, line 25 and Fig. 3. Suzuki's motor 2 drives the crank 3, which in turn moves the tail 11 side to side by way of a link 6 to move the tail 11 about a tail axis that is parallel to the wing axis. See Suzuki at col. 2, lines 52-67 and Fig. 3. However, Suzuki's wings 23 do not include an end that moves along a non-circular path. Rather, the wings 23 move entirely along a circular path either toward or away from the body 1. See Suzuki at Fig. 3.

Moreover, it would not have been obvious to modify Suzuki's wings 23 to have an end that moves along a non-circular path. There is nothing in Suzuki or the cited art that would suggest such a modification to the wings 23.

As explained above, the features of claim 21 have been incorporated into claim 1. Claim 21 previously recited that the movement of the appendage along the first path includes movement of an end of the appendage along a non-circular path. The Examiner states in reference to now canceled claim 21 that it would have been obvious to modify Suzuki in a manner in which the wings 23 include an end that moves in a non-circular path. According to the Examiner, such a modification to Suzuki "would have been an obvious matter of design choice ... because Applicant has not disclosed that the movement in a non-circular path provides

an advantage, is used for a particular purpose, or solves a stated problem." However, the movement of the end of the appendage in a non-circular path is not an ornamental design choice. Rather, the movement of the appendage end is a function that is distinct from the function of a purely circular motion. See MPEP §2144.04 I.

The Examiner also states that "[o]ne of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the appendage moving in a circular path since it creates a more realistic and natural looking movement of the animal." However, the motivation to modify Suzuki must be found in the prior art, and not in applicant's disclosure. See MPEP §2143. It appears that the examiner's motivation for a more natural looking movement was taken from applicant's disclosure, which provides the "overall motion of the appendages 220 and the skin 110 of the toy 100 imparts a realistic appearance of a dog moving its paws." See the specification at page 9, lines 30-31.

For at least these reasons, Suzuki fails to describe or suggest the combination of features found in claim 1. Accordingly, claim 1 is allowable over Suzuki. Claims 2-5, 7, 8, 14-17, and 19 depend from claim 1, and are allowable for at least the reasons that claim 1 is allowable.

Independent claim 25 recites a toy including a body, a motor within the body, an appendage, a tail device, and a neck device. The appendage is coupled to the body of the toy and actuated by the motor to rotate relative to the body about a first axis. The tail device is coupled to the body of the toy and actuated by the motor to rotate relative to the body about a second axis that is perpendicular with the first axis. The neck device is coupled to the body of the toy and actuated by the motor to rotate relative to the body about a third axis that is parallel with the first axis. Applicant requests withdrawal of this rejection because Suzuki fails to describe or suggest a tail device that is actuated to rotate about a second axis that is perpendicular with a first axis about which an appendage rotates and a neck device that is actuated to rotate about a third axis that is parallel with the first axis, as recited in claim 25.

In Suzuki, the tail 11 moves about the tail axis, the wings 23 rotate about the wing axis, and the head 7 rotates about the head axis. See Suzuki at Fig. 3. However, the tail axis in Suzuki's parrot is not perpendicular with the wing axis. Rather, the tail axis is parallel with the

wing axis. See Suzuki at Fig. 3. Moreover, the head axis in Suzuki's parrot is not parallel to the wing axis. Rather, the head axis is perpendicular to the wing axis. See Suzuki at Fig. 3.

Moreover, it would not have been obvious to modify Suzuki's tail 11, wings 23, and head 7 to move in the manner described in claim 25. There is nothing in Suzuki or the cited art that would suggest such a modification to the tail 11, wings 23, and head 7. For at least these reasons, claim 25 is allowable over Suzuki. Claims 26-31 and 35-37 depend from claim 25, and are allowable for at least the reasons that claim 25 is allowable.

Independent claim 39 recites a toy including a body, a driving device within the body, an appendage, and a tail device. The driving device includes a drive shaft driven by a motor. The appendage is coupled to a rotating device positioned on the drive shaft to rotate relative to the body about a first axis. The tail device is coupled to the rotating device positioned on the drive shaft to rotate relative to the body about a second axis that is perpendicular to the first axis. Applicant requests withdrawal of the rejection of claim 39 because Suzuki fails to describe or suggest a drive shaft driven by a motor and a rotating device on the drive shaft that is coupled to both an appendage and a tail device, as recited in claim 39.

In Suzuki, the tail 11 and the wings 23 are not coupled to the same drive shaft. Rather, the tail 11 is coupled through the link 6 and the crank 3 to the motor 2 while the wings 23 are each coupled through the disk 19 and the crank 4 to the motor 2. See Suzuki at col. 2, line 55 to col. 3, line 25 and Fig. 3.

Moreover, it would not have been obvious to modify Suzuki's tail 11 and wings 23 to move in the manner described in claim 39. There is nothing in Suzuki or the cited art that would suggest such a modification to the tail 11 and the wings 23. For at least these reasons, claim 39 is allowable over Suzuki. Claims 40-45 depend from claim 39, and are allowable for at least the reason that claim 39 is allowable.

Rejection of Claims 6, 9-13, 20, 32-34, 38, and 46

Claims 6, 9-13, 20, 32-34, 38, and 46 have been rejected as being obvious over Suzuki. These claims depend from one of the independent claims discussed above. As discussed above,

it would not have been obvious to modify Suzuki's parrot to obtain the subject matter of claims 1, 25, or 39. Accordingly, claims 6, 9-13, 20, 21, 32-34, 38, and 46 are allowable for at least the reasons that claims 1, 25, and 39 are allowable, and for containing allowable subject matter in their own right.

For example, claim 6 recites that the toy includes a pivot gear coupled to the body of the toy and including a post that couples to a slot within the appendage, and gear teeth that mesh with gear teeth of the pivot gear extend from the cam such that rotation of the cam causes rotation of the pivot gear, which causes the appendage to move along the first path. As the Examiner agrees, Suzuki fails to describe or suggest such a pivot gear. Claims 9-13 each recite various additional features of the toy. Again, the Examiner agrees that Suzuki fails to describe or suggest such additional features. The Examiner states that the use of the features in claims 6 and 9-13 is a "matter of design choice." However, the use of these features, such as, for example, the pivot gear in claim 6, is not mere ornamentation since these features clearly provide a mechanical function within the toy. See MPEP §2144.04 I. For at least these reasons, the motivation provided for modifying Suzuki is inappropriate.

Rejection of Claim 18

Claim 18 has been rejected as being obvious over Suzuki in view of U.S. Patent No. 5,316,516 (Saitoh). Claim 18 depends from claim 1, which was rejected as being anticipated by Suzuki. Saitoh does not remedy the failure of Suzuki to describe or suggest movement of an end of an appendage along a non-circular path, as recited in claim 1.

Saitoh relates to a toy bird having a body 3 that rotates about a body axis relative to a leg section 2, and a head section 4 that rotates about a head axis relative to the body 3. See Saitoh at abstract and Fig. 1. However, neither the head section 4, the leg section 2, or the body 3 includes an end that moves along a non-circular path. For at least this reason, claim 1 is allowable over any possible combination of Suzuki and Saitoh, and claim 18 is allowable for at least the reason that claim 1 is allowable.

Rejection of Claims 22-24

Claims 22-24 have been rejected as being obvious over Suzuki in view of U.S. Patent No. 4,389,811 (Iwaya). Claims 22-24 depend from claim 1, which was rejected as being anticipated by Suzuki. Iwaya does not remedy the failure of Suzuki to describe or suggest movement of an end of an appendage along a non-circular path, as recited in claim 1.

Iwaya relates to a toy bird having a body 20 that houses a motor 31, a bill 71 extending from the body 20, and a tail 81 extending from the body 20. See Iwaya at col. 2, lines 23-49 and Figs. 2-4. The body 20 rotates about a pivot 22 that extends along a body axis, the bill 71 pivots about a shaft 74 that extends along a bill axis, and the tail 81 pivots about a support shaft 76 that extends along a tail axis. See Iwaya at col. 4, line 56 to col. 5, line 57 and Figs. 2-4. However, neither the bill 71 nor the tail 81 includes an end that moves along a non-circular path, as recited in claim 1. For at least this additional reason, claim 1 is allowable over any possible combination of Suzuki and Iwaya, and claims 22-24 are allowable for at least the reason that claim 1 is allowable.

New claim 47

Independent claim 47 recites a method of actuating a toy having a body, a motor within the body, an appendage coupled to the body, a tail coupled to the body, and a neck device coupled to the body. The method includes rotating the appendage relative to the body about a first axis by actuating the motor, rotating the tail device relative to the body about a second axis that is perpendicular with the first axis by actuating the motor, and rotating the neck device relative to the body about a third axis that is parallel with the first axis by actuating the motor. Claim 47 is allowable at least for the reasons discussed above with respect to 25. Accordingly, applicant requests consideration and allowance of claim 47.

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Enclosed is a \$320 check for excess claim fees (\$200) and a one month extension of time fee (\$120). Please apply any other charges or credits to deposit account 06 1050.

Respectfully submitted,

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